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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
QUELER, ADAM M	

ART UNIT	PAPER NUMBER
2178	

DATE MAILED: 04/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/917,890	ROSES, JAVIER	
	Examiner	Art Unit	
	Adam M. Queler	2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *02 February 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-57* is/are pending in the application.

4a) Of the above claim(s) *1-18 and 32-40* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *19-31 and 41-57* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *02 February 2006* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *10/04/2001*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to communications: Application filed July 31, 2001, Information Disclosure Statement (IDS) Filed 10/04/2001, and Election filed 02/02/2006.

2. Claims 1-57 are pending in the case. Claims 19, 41, and 50 are elected, independent claims.

Election/Restrictions

3. Applicant's election with traverse of Group II in the reply filed on 2/2/2006 is acknowledged. The traversal is on the ground(s) that there is no serious burden. This is not found persuasive because the inventions' separate classifications are prima facie evidence of burden. Applicant alleges that because some limitations occur in both groups there would be search overlap and thus no burden. However, the inventions are different, and each limitations context in their invention is relevant to the search, and each recitation does not necessarily result in the same search occurring. Therefore there is a serious burden on the examiner.

The requirement is still deemed proper and is therefore made FINAL.

4. Claims 1-17 and 32-40 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 2/2/2006.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 50-57 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 50-57 are drawn to functional descriptive material NOT claimed as residing on a computer readable medium. MPEP 2106.IV.B.1(a) (Functional Descriptive Material) states:

> "Data structures not claimed as embodied in a computer-readable medium are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer."
>
> "Such claimed data structures do not define any structural or functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized."

The claims, while defining a "system" as well as a "server", do not define a "computer-readable medium" and is thus non-statutory for that reasons. A "system" as well as a "server" can range from paper on which the program is written, to a program simply contemplated and memorized by a person. The Office suggests amending the claim to embody the program on "computer-readable medium" in order to make the claim statutory.

> "In contrast, a claimed computer-readable medium encoded with the data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory." - MPEP 2106.IV.B.1(a)

Claim Rejections - 35 USC § 112

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. **Claims 52-57 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.** The claim(s) contains subject matter which was not

described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 52 claims a user device. There is no mention or definition of this term in the specification or the claims. Assuming the issue of what Applicant intends as user device is satisfactorily explained, it is suggested that the specification will not convey to one of ordinary skill in the art that Applicant invented the combination with all "user devices."

9. **Claims 52-57 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement.** The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. As there is no explanation of what is meant by a "user device" (claim 52) one of ordinary skill would undoubtedly have to resort to undue experimentation in order to make the invention.

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 19 – 24, and 52-57 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

At issue are the terms "at least one image" "high-resolution image of the image" "low resolution image of the image." The multiple usage of the word "image" is what causes some ambiguities in the scope of the claims. In claim 19 "the at least one image" is a part of the receiving step, as well as the retrieving step. However, in claims 22 and 23, these are shown to be different images, the low resolution and high resolution images. It appears Applicant

intendeds the "at least one image" to mean the logical image, or the content, for example a ball or an orange. While the "high-resolution image of the image" and "low resolution image of the image" are different versions of the same content. However, the plain meaning of the claim does not clearly convey that. The Office recommends changing the "high(low) resolution image" to the "high (low) resolution version," to avoid the conflict in scopes and retain the intended meaning of the claims. The claims will be considered to have this meaning for examining purposes only.

Regarding dependent claim(s) 21, the steps of receiving storing and retrieving do not make sense when taken together. If an image was received from the remote device, and then stored, how could it then be retrieved again? For examining purposes only, only the first two steps will be considered.

Regarding dependent claim(s) 52, as explained above, there is no explanation of what a user device is. Therefore the scope is impossible to determine because one would not know what was, or was not a user device. This will be broadly interpreted for examining purposes.

Claim Rejections - 35 USC § 102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

13. Claims19-29, 31, and 41-57 rejected under 35 U.S.C. 102(e) as being anticipated by Sparks et al. (US006167382A).

Regarding independent claim(s) 19, Sparks discloses a list of images which are on the server and therefore stored on the remote device (col. 5, ll. 20-23). Sparks discloses receiving a user selection of one of the images (col. 6, ll. 7-10). Sparks discloses using the at least one image, therefore inherently it must have been retrieved (col. 6, ll. 48-55). Sparks discloses generating a document including the image (col. 5, ll. 24-35).

Regarding dependent claim(s) 20, Sparks discloses receiving the image from the remote device (col. 5, ll. 48-55). Inherently it must be stored somewhere on the client.

Regarding dependent claim(s) 21, Sparks discloses display a list of images with previews and receiving a user selection (col. 6, ll. 27-36, col. 6, ll. 7-10).

Regarding dependent claim(s) 22, Sparks teaches the preview is a low resolution image (col. 6, ll. 27-36).

Regarding dependent claim(s) 23, Sparks teaches retrieving a high resolution version of the image (col. 3, ll. 48-55).

Regarding dependent claim(s) 24, Sparks teaches the generated document includes the high resolution version (col. 3, ll. 48-55).

Regarding dependent claim(s) 25, Sparks teaches a selection of a template (col. 5, ll. 22-23). Sparks teaches the document is generated from the template (col. 3, ll. 48-55).

Regarding dependent claim(s) 26, Sparks teaches receiving attributes for an image and generating the document based on those attributes (col. 9, ll. 52-54).

Regarding dependent claim(s) 27, Spark teaches the attributes include cropping (col. 9, ll. 52-54).

Regarding dependent claim(s) 28, Sparks teaches receiving text and attributes and generating the document based on the attributes (col. 9, ll. 48-50, 54-55).

Regarding dependent claim(s) 29, Sparks teaches a text attribute can be position.

Regarding dependent claim(s) 31, Sparks teaches the remote device is a web site (col. 2, ll. 50-51).

Regarding independent claim(s) 41, at least one computer configured to facilitate purchase of a document said at least one computer being connected to at least one remote web site through the Internet, wherein said at least one computer is configured to receive at least one image from said remote web site and generate a document, said document including said at least one image (col. 1, line 65 – col. 2 line 11).

Regarding dependent claim(s) 42, Sparks discloses a web site for selecting a template (col. 5, ll. 22-23).

Regarding dependent claim(s) 43, Sparks teaches a page for selecting images (col. 6, ll. 7-10).

Regarding dependent claim(s) 44, Sparks teaches generating the document in response to image and template selection (col. 3, ll. 19-32).

Regarding dependent claim(s) 45, Sparks teaches storing an image basket (col. 6, ll. 55-60).

Regarding dependent claim(s) 46, Sparks teaches displaying the basket (col. 6, ll. 43-46).

Regarding dependent claim(s) 47, Sparks teaches generating the document as described above. Inherently, the document must be stored at some point.

Regarding dependent claim(s) 48, Sparks teaches transmitting the document over the Internet to the purchaser (col. 3, ll. 48-55).

Regarding dependent claim(s) 49, Sparks teaches displaying a preview (col. 3, ll. 13-18).

Regarding independent claim(s) 50, Spark teaches at least one server; a plurality of web sites connected to said at least one server through the Internet, wherein said at least one server is operable to store a plurality of images received from said plurality of web sites and generate a document including at least one image received from said plurality of web sites (col. 1, line 65 – col. 2 line 11).

Regarding dependent claim(s) 51, Sparks teaches generate a document including at least one image (col. 1, line 65 – col. 2 line 11). Inherently, the document must be stored at some point.

Regarding dependent claim(s) 52, Sparks teaches generating the document in response to input from the client,. which is broadly interpreted to be a user device (col. 1, line 65 – col. 2 line 11).

Regarding dependent claim(s) 53, Sparks teaches receiving a user selection (col. 6, ll. 27-36; col. 6, ll. 7-10).

Regarding dependent claim(s) 54, Sparks discloses selecting a template (col. 5, ll. 22-23).

Regarding dependent claim(s) 55, Sparks teaches storing account information (Fig. 13).

Regarding dependent claim(s) 56, Sparks teaches receiving payment c6.56-60.

Regarding dependent claim(s) 57, Sparks teaches transmitting the document (col. 3, ll. 48-55).

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

15. **Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sparks.**

Regarding dependent claim(s) 30, Sparks does not explicitly disclose printing on C paper size. Official Notice it was well known in the art at the time of the invention as well a desirable to be able to print any paper size, including C paper size. It would have been obvious to one of ordinary skill in the art at the time of the invention to use C paper size for those reasons.

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adam M. Queler whose telephone number is (571) 272-4140. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AQ

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PRIMARY EXAMINER